

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated May 03, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

Amendments to the Drawings:

Attached herewith are replacement drawings for to Figures 1-3. It is believed these replacements do not involve any introduction of new matter. Consequently, entry of these replacement drawings is believed to be in order and is respectfully requested.

Attachment: Replacement Sheets for Figures 1-3

REMARKS

Claims 1, 3-8, 11-19 and 21-24 are pending in the present application. No additional claims fee is believed to be due.

Claims 2, 9 10, and 20 are canceled without prejudice.

Claims 1, 8 and 17 have been amended to more specifically characterize and claim Applicant's invention. Support for these amendments are found in original Claims 8-10, and at page 3, line 27 – page 5, line 6; page 8, line 27 – page 9, line 2; and page 12, line 9 – page 13, line 13 of the specification.

Claim 3-6 had been amended to more specifically characterize and claim Applicant's invention. Support for these amendments are found at page 11, line 3 – page 12, line 8 of the specification.

Claim 11 has been amended to correct the claim dependency to canceled Claim 10. Support for this amendment is found in Claims 8-11, as originally filed.

Claim 21 has been amended to correct the claim dependency to canceled Claim 20. Support for this amendment is found in Claims 17, 20 and 21, as originally filed.

Claim 22 has been amended to correct a typographical mistake regarding the inadvertent omission of "." at the end of the claim.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Claim Objections

The Office Action states that Claim 22 is objected to because it appears that the claim is missing a "." at the end of the claim. As noted above, Claim 22 has been amended to remedy the inadvertent omission of punctuation and, it is submitted, the objection is now rendered moot and should be withdrawn.

Rejection Under 35 USC 112, Second Paragraph

The Office Action States that Claims 2 and 3 are rejected for failing to particularly pointing out and distinctly claiming the subject matter which the Applicant claims as its invention. The Office Action states that that Claims 2 and 3 recite the limitation "the other factors," thereby rendering the claim unclear as to what other factors the Applicant is referring due to a lack of antecedent basis. Applicant notes that Claim 3 does not contain the phrase "the other factors," but Claims 5 and 6 do utilize this phrase. Applicant assumes that the Examiner intended to refer to Claims 5 and 6, instead of Claim 3, in making the present rejection and will respond accordingly. If Applicant's assumption is in error the Applicant invites the Examiner to contact the Applicant's attorney.

As noted above Claim 2 has been cancelled without prejudice, and Claims 5 and 6 have been amended to provide proper antecedent basis for all elements of the claims. Accordingly Applicant respectfully suggests that continued rejection of Claims 5 and 6 on these grounds would be improper, and that the rejections should be withdrawn.

Rejection Under 35 USC 101

Claims 1-6 and 8-24 have been rejected under 35 USC 101 as being directed towards unpatentable subject matter. The Office Action states that Applicant's claimed invention is directed to non-statutory subject matter in that the invention fails to satisfy the "technological arts" test set forth in *In re Toma*, 575 F.2d 872, 197 USPQ (BNA) 852 (CCPA 1078). Applicant respectfully asserts that the rejection under 35 USC 101 on these grounds is in error and should be withdrawn.

The Office Action cites the case of *In re Toma*, 575 F.2d 872, 197 USPQ (BNA) 852 (CCPA 1978) for the proposition that inventions must pass a "technological arts" test in order to be deemed patentable subject matter under 35 USC 101 (Office Action Dated 11/05/2004; Page 3, Lines 15 –18). Applicant respectfully asserts that reliance on *In re Toma* for this proposition is incorrect and inappropriate.

The Office Action specifically states that the court in *In re Toma* "found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer" (emphasis added) (Page 2, Line 24 – Page 3, Line 2). Applicant respectfully asserts that this interpretation of *In re Toma* is in error. The court in *In re Toma* was not creating a "technological arts" test, but instead was specifically addressing the rationale of the Examiner's in the final rejection of the subject claims, under 35 USC 101, that a computerized method of translating languages was not within the

“technological arts.” The Patent Office in *In re Toma* argued that “as far as computer-related inventions are concerned, only those inventions that “enhance the internal operation of the digital computer” are ‘technological’ or ‘useful’ arts.” *In re Toma* 575 F.2d 872, 877. The Patent Office further argued that the subject claims were not statutory subject matter because “natural language translation is a ‘liberal art’ and that effecting the translation by means of a machine does not transform the activity a ‘technological art’.” *Id.* The Court disagreed with this position.

The Court in *In re Toma* stated that:

The “technological” or “useful” arts inquiry must focus on whether the claimed subject matter (a method of operating a machine to translate) is statutory, not on whether the product of the claimed subject matter (a translated text) is statutory, not on whether the prior art which the claimed subject matter purports to replace (translation by human mind) is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it enhances” the operation of a machine.

The Court, in stating such, was not establishing a “technological arts” test for patentable subject matter, but was rather specifically reversing the holding of the Board of Patent Appeals and Interferences that a computer enabled translation method for translating a source language into a target language was not statutory subject matter because such a method was not within the “technological arts.” Accordingly, *In re Toma* does not, in fact, create a “technological arts” test for statutory subject matter under 35 USC 101.

As no such “technological arts” test exists, Applicants respectfully assert that continued rejection of Claims 1-6 and 8-24, as being directed towards unpatentable subject matter on these grounds, would be in error and that the rejection should be withdrawn.

Rejection Under 35 USC 102(b) Over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1)

Claims 1-9 and 12-24 have been rejected under 35 USC 102(b) as being unpatentable over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1). Applicant respectfully obviates this rejection.

As is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984). Furthermore, in a §102(b)

rejection there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

As the Office Action expressly recognizes that the *Dulaney et al* reference does not disclose the use scenario data operable to receive hypothetical sets of constant value data (Office Action dated 11/03/2005, Page 8, Lines 11-13), Applicant respectfully asserts that the above referenced claims, as amended, are patentable and respectfully requests that the rejection under 35 USC 102(b) be withdrawn.

Rejection Under 35 USC 103(a) Over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1) in view of *Jameson* (U.S. Pat. No. 6,625,577 B1)

Claims 10 and 11 have been rejected under 35 USC 103(a) as being unpatentable over *Dulaney et al* (U.S. Pat. No. 6,341,269 B1) in view of *Jameson* (U.S. Pat. No. 6,625,577 B1). Applicants respectfully traverse this rejection as there is no motivation to combine the cited references to achieve Applicant's claimed invention. Therefore, Applicants' contend that the claimed invention is unobvious and that the rejection should be withdrawn.

As is fundamental, a *prima facie* case of obviousness must be based on facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (C.C.P.A. 1970). When the rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (B.P.A.I. 1993).

As is well settled, an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would *impel* one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993). The rejection fails to provide any reason why one would be motivated, let alone impelled, to combine the *Dulaney et al* and *Jameson* references in the manner suggested by the Examiner. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness.

A *prima facie* case of obviousness, however, requires that the rejection describe with specificity **why** one skilled in the art would have combined two references to arrive at the claimed invention. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (CAFC 1999). ("Our case law makes clear

that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of *the requirement for a showing of the teaching or motivation to combine prior art references.*"). In the present case, no such explanation is found in the rejection.

Thus, the rejection is not supported by the kind of specificity required to sustain a conclusion of obviousness. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1262 (BPAI 1992).

Obviousness, however, cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. Obviousness *must* be based upon facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (CCPA 1970). When a conclusion of obviousness is not based upon facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993).

Moreover, whether or not *Dulaney et al* and *Jameson* are non-analogous arts, it remains that the question of "non-analogous art" is relevant to whether it would be proper to combine references. *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). That is, even when references are in related arts, the Examiner still has the burden of establishing (1) that there is a suggestion or motivation to combine the references relied upon, and (2) that the references, when so combined, contain the requisite suggestion and motivation which would have led one to combine the particular disclosure relied upon and to make the invention as claimed. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner was required to demonstrate *where* in *Dulaney et al* and *Jameson* there is a suggestion which would have "strongly motivated" one to make product factor optimization systems as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1986). The type of motivation which would have "*impelled*" one to do so (*Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993)), and the type of suggestion that the changes "*should*" be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Because the Examiner has not identified *any* suggestion, reason, or other motivation, including suggestion of desirability, for *why* one would have combined the *Dulaney et al* and *Jameson* references, the rejection should be withdrawn. Accordingly, Applicant respectfully asserts that for these reasons the rejection of the above referenced claims under 35 USC 103(a) is in error and should be withdrawn.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the objection to Claim 22, and the rejections under 35 USC 101, 35 USC 102(e), 35 USC 103(a), and 35 USC 112, Second Paragraph. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 3-8, 11-19 and 21-24.

Respectfully submitted,
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**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED
COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period. ***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.***

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), ***(previously presented) and (not entered)***. The text of all pending claims, ***including withdrawn claims***, must be submitted each time any claim is amended. Canceled ***and not entered*** claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) ***for deletion of five characters or fewer, double brackets may be used (e.g., [[error]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks)), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as).*** An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.

(3) The text of pending claims not being currently amended, ***including withdrawn claims***, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

06/30/03 Flyer for mailing with all Office actions by all TCs (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.

(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.

(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 - 5 ((canceled))).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a green blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

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Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for *deletion of five characters or fewer, double brackets may be used (e.g., [[error]])*; and (2) if *strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks)*, double brackets must be used (e.g., [[4]]). *As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)*

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, *and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations*. Any replacement drawing sheet must *be identified in the top margin as "Replacement Sheet"* and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled "Annotated Sheet Showing Changes" and accompany the replacement sheet as an appendix to the amendment*. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patent.practice@uspto.gov or by phone at (703)305-1616.

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